

REMARKS

I. Status Summary

Claims 1-42 and 105-110 are pending and have been examined by the United States Patent and Trademark Office (hereinafter "the Patent Office") in a Final Official Action dated April 29, 2009 (hereinafter "the Final Official Action"). A Notice of Appeal was timely filed on October 29, 2010. In lieu of an appeal brief, Applicants respectfully submit this Amendment along with a Request for Continued Examination (RCE).

Claims 1-42, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are obvious over U.S. Patent No. 6,281,189 to Heimann et al. (hereinafter "Heimann") in view of U.S. Patent Application Publication No. 2003/0213747 of Carbonell et al. (hereinafter "Carbonell"). Claims 1-19, 21-28, 33-42, 105, and 110 have also been rejected under this section over U.S. Patent No. 5,143,639 to Krawack (hereinafter "Krawack") in view of Carbonell. Claims 20 and 29-32 have also been rejected under this section over Krawack in view of Carbonell and further in view of Heimann.

Claims 1-19, 21-28, 33-43, and 105-110 have also been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 and 3-17 of co-pending U.S. Patent Application Serial No. 11/248,782 (now U.S. Patent No. 7,547,672) in view of Carbonell.

Claim 105 has been amended. The amendments to claim 105 are designed to convert dependent claim 105 into an independent claim. Support for the amendment can be found throughout the specification as filed, including at page 9, lines 9-20, and page 18, line 16, through page 19, line 4. Additional support can be found in claim 1. Thus, no new matter has been added by the amendment to claim 105.

Additionally, new claim 111 has been added. Support for claim 111 can be found in claim 1 as filed. Additional support can also be found at page 18, line 16, through page 19, line 6, and in Example 2.

Reconsideration of the application as amended and in light of the remarks set forth hereinbelow is respectfully requested.

II. Telephone Interview Summary

A telephone interview was scheduled and conducted on October 20, 2009. Participating in the interview were Examiner Gregory R. Del Cotto and Applicants' counsel of record, Arles A. Taylor, Jr. and Christopher P. Perkins. The cited art of record was discussed, as were several potential claim amendments. Additionally, the previously filed Declaration of Robert E. Troxler, Ph.D. pursuant to 35 C.F.R. § 1.132 (hereinafter the "Troxler Declaration") was discussed. Applicants respectfully submit that the comments presented herein are believed to be consistent with the discussions with the Examiner in the telephone interview. While no agreements were reached, it is believed that the unexpectedly superior results shown in the Troxler Declaration of record were clarified for the Examiner, including with regard to the use of methyl soyate as a proxy for biodiesel, as discussed in more detail herein below. Applicants wish to extend their most sincere thanks to Examiner Del Cotto for his time and consideration in participating in the telephone interview.

III. Responses to the Obviousness Rejections

Claims 1-42, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are obvious over Heimann in view of Carbonell. Claims 1-19, 21-28, 33-42, 105, and 110 have also been rejected under this section over Krawack in view of Carbonell. Claims 20 and 29-32 have also been rejected under this section over Krawack in view of Carbonell and further in view of Heimann.

After careful consideration of the rejections and the Patent Office's bases therefor, applicants respectfully traverse the rejections and submit the following remarks.

III.A. Response to the Rejection over Heimann in view of Carbonell

Claims 1-42, 105-107, and 110 have been rejected under 35 U.S.C. § 103(a) over Heimann in view of Carbonell. According to the Patent Office, Heimann teaches a composition containing at least one soybean oil derived compound and at least one member chosen from the group of drying agent(s), co-solvents, and additives, and that the composition can comprise methyl soyate and d-limonene. The Patent Office further asserts that the composition of Heimann contains from 0.5 to 20% by weight of at least

one drying agent, about 1 to about 30% by weight of at least one co-solvent, additives from 0 to about 25% by weight, and 5 to 75% by weight of methyl soyate. The Patent Office cites column 1, lines 45-69 in support of this contention.

The Patent Office further asserts that Heimann teaches that suitable additives include surfactants (e.g. anionic and nonionic), emulsifiers, antimicrobial compounds, etc., and that suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof among others. The Patent Office further asserts that Heimann teaches that additives may be added to the compositions including dipropylene glycol n-butyl ether (butyl carbitol), etc, and that the inventive composition disclosed therein can be employed as a general purpose cleaner, parts cleaner, engine degreaser, tar and asphalt remover, printing press cleaner, metal cleaner, etc. The Patent Office cites column 1, lines 30-45, in support of this contention.

The Patent Office acknowledges that Heimann does not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Carbonell is asserted by the Patent Office to teach environmentally friendly solvents used to dissolve or remove residues and/or substances from substrates wherein the residue and/or substance is contacted with a generally recognized as safe solvent (GRAS) to dissolve the residue and/or substance in the solvent followed by the extraction of the residue and/or substance from the solvent such as by contact with carbon dioxide. These GRAS solvents are asserted to be environmentally responsible solvents and to include benzoic acid ester solvents such as methyl benzoic acid ester, isopropylbenzoic acid ester, methyl salicylate, ethyl salicylate, etc. Preferably, the ester containing solvent contains at least about 70-99% by weight of the one or more esters. The Patent Office cites paragraph 50 of Carbonell in support of this contention.

The Patent Office thus contends that it would be obvious to use a benzoic acid ester solvent in the cleaning composition taught by Heimann with a reasonable expectation of success, upon the further contention that Carbonell teaches the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and the further contention that

Heimann teaches the use of various co-solvents which would encompass benzoic acid ester solvents.

The Patent Office further contends that it would be obvious to formulate a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, upon the further contention that the broad teachings of Heimann in combination with Carbonell suggest a composition containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

The Patent Office maintains that both Heimann and Carbonell are combinable as prior art since they are both drawn to the same field of endeavor, namely residue removal compositions. The Patent Office further contends that Carbonell is analogous prior art relative to Heimann and one of ordinary skill in the art clearly would look to the teachings of Carbonell to cure the deficiencies of Heimann. The Patent Office maintains that Carbonell is a secondary reference relied upon for its teaching of benzoic acid ester as a solvent in a similar residue removal composition. The Patent Office maintains that one of ordinary skill in the art would have been motivated to use a benzoic acid ester solvent in the composition taught by Heimann because Carbonell teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further, Heimann et al. teach the use of various co-solvents which would encompass benzoic acid ester solvents.

This rejection is respectfully traversed and applicants respectfully submit the following.

In response to applicants' previous arguments with respect to the rejection using Heimann in view of Carbonell, the Patent Office maintains that it is well known to those skilled in the art that solvents used for removing paint, ink, graffiti, coatings, residues, etc., are interchangeable and those possessing environmentally friendly benefits are especially desirable. Applicants respectfully submit that this is an example of the Patent

Office taking official notice without the required evidentiary support. This is respectfully believed to a technical error by the Patent Office.

It is believed that one of ordinary skill in the art would not be motivated to make the combination of Heimann and Carbonell as asserted by the Patent Office. No motivation is seen to prepare a composition comprising an aromatic ester and an aliphatic ester as presently claimed. It is believed that one of ordinary skill in the art would only find motivation to combine an aromatic ester and an aliphatic ester in accordance with the presently claimed subject matter only after a review of the instant specification as filed. Indeed it is impermissible to use the specification of a patent application as a template to combine the teachings of the cited art. Thus, it is believed that the present combination of Heimann and Carbonell is cited based on hindsight review of the present specification and is therefore not believed to support the instant rejection.

To elaborate, applicants respectfully submit that the definition that the Patent Office has used for “co-solvent” finds no support in the specification of Heimann. “Co-solvent” is used in the following contexts in this reference: A cleaning composition comprising a combination comprising methyl soyate, d-limonene, an amount of at least one pH modifying agent effective to cause said composition to have an acidic pH, and at least one co-solvent comprising water and wherein said composition is substantially free of methyl ethyl ketone. The composition can also include at least one co-solvent for the soybean oil derived compound and/or the drying agent. It is believed to be clear from this sentence that the co-solvent is “for the soybean oil derived compound and/or the drying agent”.

This is not exactly the same context as this term is used in the instant application and is not consistent with the idea of being “another solvent” generically like the Examiner is asserting. The co-solvent can comprise at least one member selected from the group consisting of water, soybean oil, hydrocarbon glycols, mixtures thereof, among others. The co-solvent can also comprise at least one propellant that is used for pressurized dispensing of the composition. In each of these contexts, the “co-solvent” is employed for solubilizing the soybean oil derived compound and/or the other components of the composition. There is no basis for asserting that “co-solvent”

generally refers to a second solvent that is designed to have activity in dissolving the "residue", and it is believed to be only with the use of hindsight that this erroneous definition can be attached.

Summarily, applicants respectfully submit that contrary to the Patent Office's assertion, the term "co-solvent" as that term is used in Heimann would not include a benzoic acid ester. Benzoic acid esters like other aromatic esters would not increase the solubility of methyl soyate in aqueous solution as would the "water, soybean oil, hydrocarbon glycols, [and] mixtures thereof" disclosed in Heimann. As such, applicants respectfully submit that the Patent Office's assertion that "co-solvent" would equate to "additional solvent" is clearly inconsistent with the meaning that the term has been given in the Heimann reference. Applicants thus respectfully submit that the Patent Office has interpreted the Heimann reference in a way that contrary to how it would be interpreted by one of ordinary skill in the art, which is believed to be improper.

As a result, applicants respectfully submit that the Patent Office has not established that one of ordinary skill in the art would have added a benzoic acid ester to the composition disclosed in Heimann, and thus has not presented a *prima facie* case of obviousness of claim 1 over Heimann in view of Carbonell. Withdrawal of the rejection of claim 1 is therefore respectfully requested.

Claims 2-42, 105-107 and 110 all depend directly or indirectly from claim 1, and thus are also believed to be distinguished over the cited combination. As such, applicants respectfully request that the instant rejection of claims 1-42, 105-107 and 110 be withdrawn at this time.

Referring now particularly to claim 105, Carbonell is asserted to teach that the compositions contain at least 70% by weight of a benzoic acid ester solvent Heimann, which is asserted by the Patent Office to be the primary reference, teaches that co-solvents are used in the compositions in amounts from 1 to 30% by weight. Claim 105 recites *inter alia* that that the composition comprises from about 40% to about 60% by weight of an aromatic ester, wherein the aromatic ester is selected from the group consisting of methyl benzoic acid ester, ethyl benzoic acid ester, n-propyl benzoic acid ester, isobutyl benzoic acid ester, n-butyl benzoic acid ester, tert-butyl benzoic acid ester, isomers of pentyl benzoic acid ester, isopropyl benzoic acid ester, and

combinations thereof. Claim 105 further recites that the composition comprises for about 30% to about 60% by weight of an aliphatic ester, wherein the aliphatic ester comprises a fatty acid methyl ester. Claim 105 also recites that the composition comprises from about 0% to about 10% by weight of a co-solvent. It is thus believed that the cited combination does not disclose or suggest each and every element of current claim 105. It is also believed that the cited combination does not disclose or suggest each and every element of claims 106 and 107. It is thus believed that claims 105-107 are further distinguished over the cited combination. Withdrawal of the rejection of claims 105-107 based on Heimann in view of Carbonell is therefore respectfully requested. Allowance of these claims is also respectfully requested.

Turning now to claim 110, applicants respectfully submit that the Patent Office has provided no discussion regarding how Heimann in view of Carbonell would suggest the subject matter of this claim. Rather, the Patent Office merely asserts that "the teachings of Heimann et al in combination with Carbonell et al would suggest compositions having the same pH, flash point, and other characteristics of the composition as recited by the instant claims because Heimann et al in combination with Carbonell et al suggest compositions containing the same components in the same proportions as recited by the instant claims". See Final Office Action, page 6. Applicants respectfully submit that there is no disclosure in either Heimann or Carbonell of compositions that are at least as efficient as diesel fuel for removing petroleum residues from substrates, which is an element of claim 110.

Therefore, applicants respectfully submit that Heimann in view of Carbonell does not support a rejection of claim 110 under 35 U.S.C. § 103(a). As a result, applicants respectfully request that the instant rejection of claim 110 also be withdrawn at this time, for at least this additional basis.

III.B. Response to the Rejection over Krawack in view of Carbonell

Claims 1-19, 21-28, 33-42, 105, and 110 have been rejected under 35 U.S.C. § 103(a) over Krawack in view of Carbonell. According to the Patent Office, Krawack teaches compositions for removing inks and the like from printing machines. These compositions are asserted to contain a mixture of 50-100% by weight of a C<sub>1</sub>-C<sub>5</sub> alkyl ester of an aliphatic C<sub>8</sub>-C<sub>22</sub> monocarboxylic acid or a mixture of such esters, 0-50% by

weight of vegetable oil, 0-10% by weight of a surfactant, and a corrosion inhibitor in an amount of up to 2% by weight.

While the Patent Office concedes that Krawack does not teach the use of a benzoic acid ester, the Patent Office asserts that this deficiency is cured by Carbonell. The Patent Office thus asserts that it would have been *prima facie* obvious to one of ordinary skill in the art to have used a benzoic acid ester in the cleaning composition taught by Krawack because Carbonell teaches the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents.

The Patent Office asserts that it would *prima facie* case obvious to use a benzoic acid ester in the cleaning composition taught by Krawack, with a reasonable expectation of success, upon the contention that Carbonell teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents. The Patent Office cites *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) and MPEP 2144.06 in support of this contention.

Applicants respectfully traverse the Patent Office's assertion that it is appropriate under *Kerkhoven* to define the "purpose" of Krawack and of Carbonell as simply "residue cleaning compositions". Rather, applicants submit that as acknowledged by the Patent Office, the "purpose" of Krawack is dissolving inks and the like. The purpose of Carbonell, on the other hand, is dissolving petroleum products. Applicants urge that one of ordinary skill in the art would not look to Carbonell to find solvents that would improve the cleaning of inks and the like since inks and petroleum products are not chemically similar.

Thus, and contrary to the Patent Office's assertion, Carbonell does not teach the use of solvents such as benzoic acid esters in similar cleaning compositions. As a result, applicants respectfully submit that the Patent Office has not presented a *prima facie* case of obviousness of claim 1 or of claim 110, and request that the Patent Office reconsider its position with respect thereto in light of applicants' remarks presented herein. Claims 2-19, 21-28, and 33-42 all depend directly or indirectly from claim 1, and thus are also believed to be distinguished over Krawack in view of Carbonell.

Claim 105 recites *inter alia* that that the composition comprises from about 40% to about 60% by weight of an aromatic ester, wherein the aromatic ester is selected from the group consisting of methyl benzoic acid ester, ethyl benzoic acid ester, n-propyl benzoic acid ester, isobutyl benzoic acid ester, n-butyl benzoic acid ester, tert-butyl benzoic acid ester, isomers of pentyl benzoic acid ester, isopropyl benzoic acid ester, and combinations thereof. Claim 105 further recites that the composition comprises for about 30% to about 60% by weight of an aliphatic ester, wherein the aliphatic ester comprises a fatty acid methyl ester. Claim 105 also recites that the composition comprises from about 0% to about 10% by weight of a co-solvent. It is thus believed that the cited combination does not disclose each and every element of current claim 25. It is also believed that the cited combination does not disclose each and every element of claims 106 and 107. It is thus believed that claims 105-107 are further distinguished over the cited combination. Withdrawal of the rejection of claims 105-107 based on Krawack in view of Carbonell is therefore respectfully requested. Allowance of these claims is also respectfully requested.

Accordingly, applicants respectfully request that the rejection of claims 1-19, 21-28, 33-42, 105, and 110 under 35 U.S.C. § 103(a) over Krawack in view of Carbonell be withdrawn at this time. Allowance of these claims is also respectfully requested.

*III.C. Response to the Rejection over Krawack in view of Carbonell and further in view of Heimann*

Claims 20 and 29-32 have been rejected under 35 U.S.C. § 103(a) over the combination of Krawack, Carbonell, and Heimann. According to the Patent Office, it would have been *prima facie* obvious to use d-limonene as a fragrance in the composition taught by Krawack because Heimann taught the use of d-limonene as an odorant in a similar cleaning composition, and further because odorants such as d-limonene are notoriously well known as suitable for use in cleaning compositions and desirable for such use.

Applicants respectfully submit that claims 20 and 29-32 all depend directly from claim 1, and thus include all the limitations of claim 1. Applicants respectfully submit that the comments presented hereinabove with respect to the rejections of claim 1 over the combination of Heimann and Carbonell and Krawack and Carbonell are equally

applicable and persuasive here. Thus, applicants respectfully submit that since the Patent Office has failed to establish a *prima facie* case of obviousness of claim 1 over these combinations, the Patent Office has also failed to establish a *prima facie* case of obviousness of claims 20 and 29-32 since claims 20 and 29-32 all depend from claim 1.

Furthermore, claims 29-32 recite particular weight percentage elements for the aromatic ester component, aliphatic ester component, co-solvent component, and odor-masking agent component, among other components. Applicants respectfully submit that the combination of Krawack, Carbonell, and Heimann fail to suggest the weight percentage elements of these components, and thus for this additional reason it is believed that a *prima facie* case of obviousness of these claims over this combination has not been presented. As such, applicants respectfully request that the instant rejection of claims 29-32 also be withdrawn at this time, for at least this additional basis.

Accordingly, applicants respectfully submit that claims 20 and 29-32 are distinguished over the combination of Krawack, Carbonell, and Heimann, and further respectfully request that the rejection under 35 U.S.C. § 103(a) over this combination be withdrawn at this time. Allowance of these claims is also respectfully requested.

#### III.D. Response to the Double Patenting Rejection

Claims 1-19, 21-28, 33-43, and 105-110 have been provisionally rejected under the judicially-created doctrine of non-statutory obviousness-type double patenting over claims 1 and 3-17 of U.S. patent application serial number 11/248,782 (hereinafter the "782 Application"), now U.S. Patent No. 7,547,672, in view of Carbonell. The Patent Office asserts that claims 1 and 3-17 of the '782 Application' encompass all the material limitations of the instant claims except for the inclusion of an aromatic ester. Carbonell are relied upon as set forth above.

The Patent Office further asserts would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a benzoic acid ester solvent in the cleaning composition claimed by the '782 Application', with a reasonable expectation of success, because Carbonell teach the use of solvents such as benzoic acid esters in similar cleaning compositions and that benzoic acid esters are environmentally friendly solvents and further asserts that the '782 Application' claims the use of various co-

solvents which would encompass benzoic acid ester solvents. This rejection is respectfully traversed.

Representative claims that issued from the '782 Application' are as follows:

Claim 1: A composition for cleaning and recycling comprising: about 0 to about 50 weight percent diluent; about 1 to 50 weight percent surfactant; about 0.5 to about 20 weight percent co-solvent, wherein the co-solvent is selected from a group consisting of propylene glycol monomethyl ether, dipropylene glycol monomethyl ether, tripropylene glycol monomethyl ether, dipropylene glycol n-propyl ether, tripropylene glycol n-propyl ether, dipropylene glycol n-butyl ether, propylene glycol n-butyl ether, tripropylene glycol n-butyl ether, dipropylene glycol dimethyl ether, fatty acid methyl esters, and fatty acid amides; and about 10 to about 99.5 weight percent 2-ethylhexyl ester, wherein the 2-ethylhexyl ester is selected from the group consisting of 2-ethylhexylcinnamate, of 2-ethylhexylsalicylate, 2-ethylhexyladipate, 2-ethylhexylstearate, and 2-ethylhexylsuccinate.

Claim 11: A composition for cleaning and recycling according to claim 1 having: about 0.5 to about 2 weight percent co-solvent; and about 70 to about 99.5 weight percent 2-ethylhexyl ester, wherein the 2-ethylhexyl ester is selected from the group consisting of 2-ethylhexylcinnamate, of 2-ethylhexylsalicylate, 2-ethylhexyladipate, 2-ethylhexylstearate, and 2-ethylhexylsuccinate.

Claim 12: A composition for cleaning and recycling according to claim 1 having: about 5 to about 30 weight percent surfactant; and about 70 to about 90 weight percent 2-ethylhexyl ester, wherein the 2-ethylhexyl ester is selected from the group consisting of 2-ethylhexylcinnamate, of 2-ethylhexylsalicylate, 2-ethylhexyladipate, 2-ethylhexylstearate, and 2-ethylhexylsuccinate.

It is believed that one of ordinary skill in the art would not be motivated to make the combination of the claims of the '782 Application' and Carbonell as asserted by the Patent Office. No motivation is seen to prepare a composition comprising an aromatic ester and an aliphatic ester as presently claimed. It is believed that one of ordinary skill in the art would only find motivation to combine an aromatic ester and an aliphatic ester in accordance with the presently claimed subject matter after a review of the instant specification as filed. Indeed it is impermissible to use the specification of a patent

application as a template to combine the teachings of the cited art. Thus, it is believed that the present combination of the claims of the '782 Application and Carbonell is cited based on hindsight review of the present specification and is therefore not believed to support the instant rejection.

Further, applicants respectfully submit that the comments presented hereinabove with respect to the rejections of claim 1 over the combinations of Heimann and Carbonell, Krawack and Carbonell, and Krawack, Carbonell, and Heimann are equally applicable and persuasive here. Thus, applicants respectfully submit that since the Patent Office has failed to establish a *prima facie* case of the obviousness of claim 1 over these combinations, the Patent Office has also failed to establish a *prima facie* case of obviousness over the claims issuing from the '782 Application and Carbonell. Accordingly, withdrawal of the rejection of claims 1-19, 21-28, 33-43, and 105-110 based under obviousness-type double patenting based on the patent issuing from the '782 Application in view of Carbonell is respectfully requested.

Turning now to claims 105-109, it is respectfully submitted that the cited combination of the claims of the '782 Application and Carbonell do not disclose or suggest each and every element of these claims. Thus, for at least this additional reason it is believed that the cited combination does not support the present rejection of claims 105-109. To elaborate, there is no disclosure or suggestion in the cited combination of the inclusion of an aromatic ester in the amount of from about 30% to about 50% by weight as recited in claim 108. Further, there is no disclosure or suggestion in the cited combination of a composition comprising from about 40% to about 60% by weight of an aromatic ester wherein the aromatic ester is selected from among those listed in claim 105. Indeed, there is also no disclosure or suggestion in the cited combination of the inclusion of an aliphatic ester at from about 30% to about 60% by weight wherein the aliphatic ester comprises a fatty acid methyl ester. Further, claims 106 and 107 recite elements that are also not disclosed or suggested in the cited combination.

It appears that in the claims that issued from the '782 Application fatty acid methyl esters are described as a co-solvent and are present in about 0% to about 20%. See claim 1 of the '782 Application as presented hereinabove. Additionally, claim 12

from the '782 Application recites no co-solvent component and also that the 2-ethylhexyl ester component is about 70-90%. Thus, no teaching or suggestion of the elements of present claims 105-109 can be found in the cited combination and no suggestion or motivation can be found in the claims of the '782 Application in view of Carbonell or to alter the recited ester percentage to reflect that recited in present claims 105-109.

Accordingly, withdrawal of the rejection of claims 1-19, 21-28, 33-43, and 105-110 based under obviousness-type double patenting based on the patent issuing from the '782 Application in view of Carbonell is respectfully requested. Allowance of the claims is respectfully requested.

It is further noted that claim 43 was cancelled in response to the previous Office Action and it is believed that the inclusion of claim 43 in the present rejection was inadvertent. Accordingly, any aspect of the instant rejection related to claim 43 is believed to be moot.

III. E. Evidence of Unexpectedly Superior Results

Assuming *arguendo* that the Patent Office has established a *prima facie* case of obviousness of the present claims over one or more of the combinations presented in the Final Official Action, applicants respectfully submit the following additional remarks. It is axiomatic that a *prima facie* case of obviousness can be rebutted by evidence of unexpectedly superior results. Applicants respectfully submit that as shown in the previously filed Troxler Declaration, the presently claimed compositions are vastly superior to compositions consisting of an aliphatic ester alone (e.g., methyl soyate) at dissolving asphalt. Additionally, the combination of an aliphatic ester and an aromatic ester as claimed in the instant application provides much better than additive results vis-à-vis an aliphatic ester and an aromatic ester individually (see Points 8 and 9 of the Troxler Declaration).

The Patent Office asserts that the Troxler Declaration is not sufficient to place the instant claims in condition for allowance. The Patent Office asserts that there has been no comparison made to the closest prior art; Heimann and Krawack teach methyl soyate and various esters, respectively, while the Declaration provides data with respect to "biodiesel" which Applicant admits is a "proxy" for methyl soyate.

The Patent Office fails to articulate why a proxy for biodiesel is inappropriate in this instance. The definition of "biodiesel" in the present specification is "mono-alkyl esters of long-chain fatty acids derived from vegetable oils, such as soybean oil, or animal fats, or recycled frying vegetable oil wastes designated B100, and meeting the requirements of ASTM D 6751. A typical profile of methyl esters of soybean oil is: 12% palmitic ( $C_{15}H_{31}CO_2CH_3$ ); 5% stearic ( $C_{17}H_{35}CO_2CH_3$ ); 25% oleic ( $C_{17}H_{33}CO_2CH_3$ ); 52% linoleic ( $CH_3(CH_2)_4CH=CHCH_2CH=CH(CH_2)_7CO_2CH_3$ ); and 6% linolenic ( $CH_3(CH_2CH=CH)_3(CH_2)_7CO_2CH_3$ )". Each and every one of these is an aliphatic ester, and thus is consistent with the assertions that have been made by the Patent Office concerning Heimann.

Additionally, the Patent Office asserts that the data presented in the Troxler Declaration are not commensurate in scope with the instant claims. The Patent Office asserts that the instant claims recite broad amounts of any aromatic ester and broad amounts of any aliphatic ester while the Troxler Declaration provides data with respect to one specific embodiment containing 54% of isopropyl benzoic acid ester and 40% biodiesel which is not commensurate in scope with the instant claims. The Patent Office asserts that the Declaration is not sufficient to show the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the instant claims.

Applicants respectfully submit that the previously filed Troxler Declaration does indeed support unexpected results in accordance with the scope of the present claims. Particularly, as argued hereinabove, it is noted that no motivation to make a composition comprising an aromatic ester and an aliphatic ester as presently claimed is seen based on the cited art of record. As such, the Troxler Declaration provides exemplary compositions comprising aromatic esters and aliphatic esters and is believed to support the patentability of the present claims. Indeed, the superior results provided in the Troxler Declaration are believed to support that one of ordinary skill in the art could not have prepared a composition comprising an aromatic ester and an aliphatic ester for removing a petroleum residue from a substrate in accordance with the present claims with a reasonable expectation of success. As such, it is respectfully requested

that the probative value of the Troxler Declaration be acknowledged and that the present claims be passed to allowance.

Furthermore, claims 29-32 recite particular weight percentage elements for the aromatic ester component, aliphatic ester component, co-solvent component, and odor-masking agent component, among other components. Therefore, it is believed that claims 29-32 are commensurate in scope with the Troxler Declaration.

Further, claim 105 has been amended to recite a water soluble composition for removing petroleum residue from a substrate, said composition comprising:

- (a) from about 40 to about 60% by weight of an aromatic ester, wherein the aromatic ester is selected from the group consisting of methyl benzoic acid ester, ethyl benzoic acid ester, n-propyl benzoic acid ester, isobutyl benzoic acid ester, n-butyl benzoic acid ester, tert-butyl benzoic acid ester, isomers of pentyl benzoic acid ester, isopropyl benzoic acid ester, and combinations thereof;
- (b) from about 30 to about 60% by weight of an aliphatic ester, wherein the aliphatic ester comprises a fatty acid methyl ester;
- (c) from about 0% to 10% by weight of a co-solvent;
- (d) from 0% to about 10% by weight of a cyclic terpene;
- (e) from 0% to about 1% by weight of an odor-masking agent; and
- (f) from 0% to about 20% by weight of a nonionic surfactant.

It is believed that claim 105 is commensurate in scope with the Troxler Declaration, as discussed in the Telephone Interview. Allowance of claim 105 is respectfully requested. Additionally, claims 106 and 107 recite *inter alia* a particular aliphatic ester and a particular aromatic ester each at particular weight percentages. As such, it is believed that claims 106 and 107 are commensurate in scope with the Troxler Declaration, as discussed in the Telephone Interview. Allowance of claim 106-107 is also respectfully requested.

Applicants respectfully submit that even if the Patent Office has presented a *prima facie* case of obviousness of the pending claims over one or more of Krawack, Carbonell, Heimann, and the '782 Application the *prima facie* case has been rebutted by the data presented in the Troxler Declaration. Therefore, applicants respectfully request

that the instant rejections of claims 1-42 and 105-110 be withdrawn at this time. Accordingly, applicants urge that claims 1-42 and 105-110 are now in condition for allowance, and respectfully solicit a Notice of Allowance to that effect.

*IV. Discussion of New Claims*

New claim 111 has been added. Support for new claim 111 is discussed hereinabove. No new matter has been added. Claim 111 is believed to be patentably distinguished over the cited art of record for at least the reason set for hereinabove with respect to the other pending claims. Accordingly, allowance of claim 111 is respectfully requested.

CONCLUSIONS

Should there be any minor issues outstanding in this matter, the Examiner is respectfully requested to telephone the undersigned attorney. Early passage of the subject application to issue is earnestly solicited.

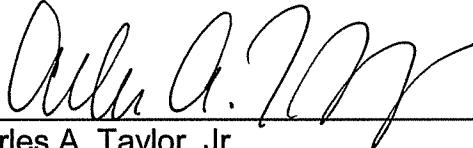
DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayments associated with the filing of this correspondence to Deposit Account Number 50-0426.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

Date: 06/01/2010

By: 

Arles A. Taylor, Jr.  
Registration No. 39,395  
Customer No. 25297  
(919) 493-8000

1456/3      AAT/dbp